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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/548,401

09/26/2005

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1788

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/548,401	<b>Applicant(s)</b> MORISAKI ET AL.	
	<b>Examiner</b> PATRICIA L. NORDMEYER	<b>Art Unit</b> 1788	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Withdrawn Rejections**

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn due to Applicant's amendments in the response dated April 4, 2011.

### **Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4 - 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application Publication No. 2-353 U in view of Barbieri (USPN 4,004,362).

JP 2-353 U discloses an adhesive tape (Figures 1 – 4), comprising: a tape body to be adhered to an adherend (Figures 1 and 2, #24), a positioning tab positioned on one end periphery of the tape body (Figures 1 and 3, #26), and a release sheet provided on a rear side of the tape body (Figure 1, #28), wherein the positioning tab and the tape body are interconnected via connecting portions that are positioned there between, the connecting portions (Figures 4, #26) respectively further including a cutting lines penetrating through the tape body (Figure 2, #27) and the release sheet (Figure 3, the line separating #28A and 28B), wherein the connecting portions are provided on side portions of one end periphery of the tape body (Figure 4; Figure 3,

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#27), wherein the portions respectively have angled portions that linearly that continue to laterally opposed end peripheries of the tape body (Figure 2, #27) as in claim 1. Regarding claim 4, the release sheet has an additional slit that is formed in a side periphery thereof (Figure 3, #28A and 28B). With regard to claim 5, the release sheet extends onto a rear side of the positioning tab beyond the connecting portion (Figure 1, #28). As in claim 6, the positioning tab has a fixing element that is positioned adjacent to the connecting portion (Figure 4, #26).

Regarding claim 7, the tape body comprises an elongated tape body (Figure 3, #24), wherein the one end periphery of the tape body corresponds to one of longitudinally opposed end peripheries of the tape body, and wherein the slit is formed so as to extend along one of the laterally opposed end peripheries of the tape body (Figure 3, #28A and 28B). With regard to claim 8, the adhesive tape is designed to be applied to a vertical frame of a vehicle door, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

However, JP 2-353 U fails to disclose two connecting portions are respectively provided on the side portions of one end periphery of the tape body, the cutting lines formed of perforations, a cutting line penetrating through the tape body and the release sheet in the same location, wherein the release sheet has slits that are respectively formed adjacent to the cutting lines so as to be peeled while leaving side peripheral portions thereof allowing only the central area to be peeled away and wherein the cutting line is arranged and constructed to be ruptured therealong, so that the positioning tab can be separated from the tape body along the cutting line.

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Barbieri teaches a tape body to be adhered to an adherend (Figures 1 and 8, #11), and a release sheet provided on a rear side of the tape body (Figures 1 and 2, #13), wherein a cutting line penetrating through the tape body and the release sheet in the same location and formed of perforations (Figure 1, #16; Figure 8, #28; Column 2, lines 42 – 44) for the purpose of protecting the adhesive while controlling the removal of the backing layer (Column 2, lines 60 – 65).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the cutting line penetrating through the tape body and the release sheet in the same location in JP 2-353 U in order to protect the adhesive while controlling the removal of the backing layer as taught by Barbieri.

With regard to the limitation of “disclose two connecting portions are respectively provided on the side portions of one end periphery of the tape body” in claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have two connecting portions attached to the tape body, since it has been held that mere duplication of working parts of device involves only routine skill in the art. MPEP 2144.04.

With regard to the limitation of “wherein the cutting line is arranged and constructed to be ruptured therealong, so that the positioning tab can be separated from the tape body along the cutting line” in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. Since Barbieri teaches that the cutting line penetrating through the tape body and the release sheet in the same location (Figure 1, #16; Figure 8, #28; Column 2, lines 42 – 44) is a perforated line, it is capable of being ruptured and separated.

With regard to the limitation of “wherein the release sheet has slits that are respectively formed adjacent to the cutting lines so as to be peeled while leaving side peripheral portions thereof allowing only the central area to be peeled away”, JP 2-353 U disclose wherein the positioning tab and the tape body are interconnected via connecting portions that are positioned there between, the connecting portions (Figures 4, #26) respectively further including a cutting lines penetrating through the tape body (Figure 2, #27) and the release sheet (Figure 3, the line separating #28A and 28B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the release sheet has slits that are respectively formed adjacent to the cutting lines so as to be peeled while leaving side peripheral portions, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. MPEP 2144.04.

### **Response to Arguments**

3. Applicant's arguments filed March 11, 2011 have been fully considered but they are not persuasive.

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In response to Applicant's argument that the connection portions do not include angled portions that linearly continue to laterally opposed end peripheries of the ear portion, JP 2-353 clearly shows the arrangement in Figure 2, with regard to the slits 27.

In response to Applicant's argument that the prior art fails to disclose the limitation of "wherein the release sheet has slits that are respectively formed adjacent to the cutting lines so as to be peeled while leaving side peripheral portions thereof allowing only the central area to be peeled away", JP 2-353 U disclose wherein the positioning tab and the tape body are interconnected via connecting portions that are positioned there between, the connecting portions (Figures 4, #26) respectively further including a cutting lines penetrating through the tape body (Figure 2, #27) and the release sheet (Figure 3, the line separating #28A and 28B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the release sheet has slits that are respectively formed adjacent to the cutting lines so as to be peeled while leaving side peripheral portions, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. MPEP 2144.04.

### **Conclusion**

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICIA L. NORDMEYER whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alicia Chevalier can be reached on (571) 272-1490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer  
Primary Examiner  
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